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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,558	05/23/2001	Michael D. Ellis	UV-200	2848

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EXAMINER	
YIMAM, HARUN M	

ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/864,558	ELLIS, MICHAEL D.	
	Examiner	Art Unit	
	Harun M. Yimam	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *161-191* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *161-191* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Note to Applicant

Art Units 2611, 2614 and 2617 have changed to 2623. Please make all future correspondence indicate the new designation 2623.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 04/04/2006 have been fully considered but are moot in view of new grounds of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 161, 174, 189 and 191 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claims 161, 174, 189 and 191 are vague and indefinite because it is unclear whether the newly added phrase "amount of time" represents determining the number of times the user has watched the program or determining how long the user has watched the program.

The phrase "amount of time" in claims 161, 174, 189 and 191 is a relative term, which renders the claims indefinite. The phrase "amount of time" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Accordingly, for the purpose of advancing prosecution on the merits, Examiner has interpreted the phrase "amount of time" in claims 161, 174, 189 and 191 to read as "how long the user has watched the program of interest" and "how long the programs have been watched".

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 161 – 165, 168 – 170, 173 – 178, 181 – 183, 186 – 188 and 190 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothmuller (US 5,635,989) in view of Bedard (US 5,801,747).

Considering claims 161 and 174, Rothmuller discloses a system and method for adding a program of interest to a watch list using an interactive television program guide at least partially implemented on user television equipment (column 4, lines 54-66), the user television equipment comprising: a display device for displaying the program of interest (column 4, lines 54-58 and column 6, lines 60-66); control circuitry (15 in figure 1) configured to: determine if a user has been watching the program of interest for a specified period of time (column 5, lines 60-67 and column 6, lines 16-27), determining the amount of time the user has watched the program of interest (by determining if the user has been watching the program of interest for a specified period of time, we also determine how long the user has watched the program of interest—column 5, lines 60-67 and column 6, lines 16-27); and automatically add the program of interest to the watch list in response to the user having watched the program of interest for the specified period of time (column 5, lines 59-61 and column 6, lines 1-4).

Rothmuller fails to disclose ranking the program of interest based on how long the user has watched the program of interest.

In analogous art, Bedard discloses ranking the program of interest based on how long the user has watched the program (Bedard—column 4, line 27 – column 5, line 6 and see figure 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rothmuller's system to include ranking the program of

interest based on how long the user has watched the program of interest, as taught by Bedard, for the benefit of organizing the access of the watch list in accordance with the level of interest in each program.

As for claims 162 and 175, they are met by the combination of Rothmuller and Bedard. In particular, Rothmuller discloses that the control circuitry is further configured to automatically remove the program of interest from the watch list in response to the user not having watched the program interest for a second specified period of time (column 6, lines 48-56).

With regards to claims 163 and 176, they are met by the combination of Rothmuller and Bedard. In particular, Rothmuller discloses that the control circuitry is further configured to remove the program of interest from the watch list in response to user input (column 7, lines 10-17).

Regarding claims 164 and 177, Rothmuller discloses a method for adding a program of interest to a watch list using an interactive television program guide.

Rothmuller fails to disclose ranking the program of interest based on how long the user has watched the program of interest.

In analogous art, Bedard discloses ranking the program of interest based on how long the user has watched the program (Bedard—column 4, line 27 – column 5, line 6 and see figure 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rothmuller's system to include ranking the program of interest based on how long the user has watched the program of interest, as taught by Bedard, for the benefit of organizing the access of the watch list in accordance with the level of interest in each program.

Considering claims 165 and 178, they are met by the combination of Rothmuller and Bedard. In particular, Bedard discloses that the control circuitry is further configured to place the program interest into the watch list in a position based on the ranking (Bedard—column 5, lines 6-33 and see figure 3).

Regarding claims 168 and 181, they are met by the combination of Rothmuller and Bedard. In particular, Rothmuller discloses that the control circuitry is further configured to automatically display the watch list on the display device prior to the start of a program on the watch list (column 7, lines 39-45 and column 7, line 66 –column 8, line 2).

Considering claims 169 and 182, they are met by the combination of Rothmuller and Bedard. In particular, Rothmuller discloses that the control circuitry is further configured to display at the top of the watch list a program that is about to start (since the favorite/watch list notification display comprises all programs that are about to start on different channels, the program displayed at the top of the favorite/watch list is a program that is about to start—column 7, lines 39 – column 8, line 2).

As for claims 170 and 183, Rothmuller discloses a method for adding a program of interest to a watch list using an interactive television program guide. Rothmuller further discloses that the viewer can maneuver a cursor on a program guide so as to highlight the program of interest (column 6, lines 64-66).

However, Rothmuller fails to disclose that the control circuitry (Microprocessor—15 in figure 1) is further configured to allow the user to highlight a program on the watch list, and simultaneously display a program the user is watching, the watch list, and information related to the highlighted program on the display device.

In analogous art, Bedard discloses that the control circuitry is further configured to allow the user to highlight (by adding a border around the program/channel window) a program on the watch list (column 7, lines 58-60), and simultaneously display a program the user is watching (the primary television display—column 7, lines 58-60), the watch list (EPG comprising viewer preferred programs—column 7, lines 39-41), and

information related to the highlighted program on the display device (see figure 5 and column 7, lines 28-64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rothmuller's system to include highlighting a program on the watch list, and simultaneously display a program the user is watching, the watch list, and information related to the highlighted program on the display device, as taught by Bedard, for the benefit of allowing the user to work with the watch list and simultaneously watch the primary television display (column 7, lines 58-60).

Considering claims 173 and 186, they are met by the combination of Rothmuller and Bedard. In particular, Bedard discloses that the information related to the highlighted program is a description of the highlighted program (Bedard—see 508 in figure 5 and column 7, lines 34-35).

As for claim 187, it is met by the combination of Rothmuller and Bedard. In particular, Rothmuller discloses that the program of interest is a television program (column 6, lines 60-66 and column 1, lines 5-10).

As for claims 188 and 190, they are met by the combination of Rothmuller and Bedard. In particular, Bedard discloses ranking the programs of interest included in the

watch list depending on program type (category or subcategory—column 4, lines 49-65).

6. Claims 166, 167, 179, and 180 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothmuller (US 5,635,989) in view of Bedard (US 5,801,747), as applied to claim 164 above, and further in view of Macrae (US 2003/0208756).

As for claims 166 and 179, Rothmuller and Bedard disclose a method for adding a program of interest to a watch list using an interactive television program guide.

Rothmuller and Bedard fail to disclose that the program of interest is a promotion.

In analogous art, Macrae discloses that the program of interest is a promotion (paragraph 0291, lines 15-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Rothmuller and Bedard to include a promotion as the program of interest, as taught by Macrae, for the benefit of providing the user with various possible interests other than just television programs.

With regards to claims 167 and 180, Rothmuller and Bedard disclose a method for adding a program of interest to a watch list using an interactive television program guide.

Rothmuller and Bedard fail to disclose automatically removing the program of interest from the watch list when the promotion is no longer available.

In analogous art, Macrae discloses automatically removing the program of interest from the watch list when the promotion is no longer available (Macrae—paragraph 0124, lines 3-8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Rothmuller and Bedard to include automatically removing a program in the absence of a promotion, as taught by Macrae, for the benefit of providing a means to advertisers to renew their advertisements (paragraph 0124, lines 8-9).

7. Claims 171, 172, 184, and 185 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothmuller (US 5,635,989) in view of Bedard (US 5,801,747), as applied to claims 170 and 183 above, and further in view of Billock (US 2002/0059581).

With regards to claims 171 and 184, Rothmuller and Bedard disclose a method for adding a program of interest to a watch list using an interactive television program guide.

Rothmuller and Bedard fail to disclose that the information related to the highlighted program is a video associated with the highlighted program.

In analogous art, Billock discloses that the information related to the highlighted program is a video associated with the highlighted program (paragraph 0078, lines 4-7 and paragraph 0080, lines 1-10 and paragraph 0064, line 3 - paragraph 0068, line 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Rothmuller and Bedard to include video as information related to the highlighted program, as taught by Billock, for the benefit of providing the user with different forms of information related to the highlighted program.

Regarding claims 172 and 185, they are met by the combination of Rothmuller, Bedard, and Billock. In particular, Billock discloses that the information related to the highlighted program is a video image associated with the highlighted program (Billock—paragraph 0064, line 3 - paragraph 0068, line 5).

8. Claims 189 and 191 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothmuller (US 5,635,989) in view of Bedard (US 5,801,747), as applied to claim 164 above, and further in view of Barrett (US 6,005,597).

With regards to claims 189 and 191, Rothmuller and Bedard disclose ranking the programs of interest included in the watch list based on the amount of time the

programs have been watched (Bedard—column 4, line 27 – column 5, line 6 and see figure 2).

Rothmuller and Bedard fail to disclose ranking the programs of interest included in the watch list based on the duration of the programs.

In analogous art, Barrett disclose ranking the programs of interest (column 7, lines 51-56) included in the watch list based on the duration of the programs (column 10, line 60 – column 11, line 19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Rothmuller and Bedard to include ranking the program of interest based on the duration of the programs, as taught by Barrett, for the benefit of providing a means to access the watch list in accordance with the different types of interests in each program.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harun M. Yimam whose telephone number is 571-272-7260. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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